

Appl. No. 10/809,561  
Amdt. Dated December 20, 2006  
Reply to an Office Action dated 09/20/06

RECEIVED  
CENTRAL FAX CENTER

DEC 20 2006

**REMARKS**

This Amendment is in response to an Office Action dated September 20, 2006. In the Office Action, claims 1-17 were rejected under 35 U.S.C. §112 (second paragraph), claims 1-4, 6-9 and 14-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Kimura (U.S. Patent No. 6,170,026). Moreover, claims 5, 10 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kimura in view of Jonsson (U.S. Published Application No. 2003/0036350) and claim 11-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kimura in view of Sekiyama (U.S. Patent No. 6,427,115).

Herein, claims 14-15 and 18 have been cancelled without prejudice. Claims 1-9, 11 and 16-17 have been amended and claims 19-21 have been added. Reconsideration of the outstanding rejections is respectfully requested.

***Rejection Under 35 U.S.C. §112***

Claims 1-17 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite. Claims 14-15 and 18 have been cancelled without prejudice and claims 1-9, 11 and 16-17 have been amended to overcome the rejection. Withdrawal of the outstanding §112 rejection is respectfully requested.

***Rejection Under 35 U.S.C. §102***

Claims 1-4, 6-9 and 14-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Kimura (U.S. Patent No. 6,170,026). Applicant respectfully requests the Examiner to withdraw the rejection because a *prima facie* case of anticipation has not been established. Before discussing the grounds for traversing the rejection, a brief summary of the teachings of Kimura may be appropriate.

Kimura appears to disclose a computing system featuring a plurality of mobile modules and a plurality of docking modules. Each docking module has an interface that allows the docking module to be removably connected to at least one of the mobile modules. Upon detecting that the mobile module is to be shut down, the CPU of the mobile module gathers a list of all current devices (pre-existing list) associated with the docking module and saves the device configuration for each device found until there are no more device configurations to save. Upon reconnection to a docking module, the CPU of the mobile module retrieves the pre-existing list and compares the listed devices to those devices presently associated with the docking module. The CPU removes devices from the pre-existing list if they are currently not associated with the docking module and continues this process until all missing devices are removed. The CPU then retrieves the list of devices associated with the current docking module and organizes configuration information for those devices

Returning back to the rejection, as the Examiner is aware, a reference must teach every element of the claim in order to anticipate a claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as

Appl. No. 10/809,561  
Amdt. Dated December 20, 2006  
Reply to an Office Action dated 09/20/06

is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that a *prima facie* case of anticipation has not been established.

For instance, with respect to independent claim 1, Applicant respectfully submits that Kimura does not describe a number of limitations set forth in claim 1, including the following limitations:

*means for conducting at least two inquiries for external devices*  
surrounding the communication device, the at least two inquiries being  
transmitted through the wireless communication unit;  
*means for receiving responses to each inquiry*, each response including  
information from one or more of the external devices; and  
*means for detecting one of the external devices as a connection object in*  
*accordance with a difference between the received responses. Emphasis added.*

More specifically, Kimura fails to disclose the "means for detecting," which is responsible for detecting one of the external devices as a connection object. Such detection is accomplished by looking at a difference between responses received to at least two inquiries as claimed, which is not performed by the computing system of Kimura.

Moreover, with respect to independent claim 16, the Office Action states that the "first [period of] time occurs before disconnection of the mobile module and the "second [period of] time" occurs after re-connection of the mobile module. *See Page 9 of the Office Action.* In accordance with this interpretation, Applicant respectfully submits that Kimura does not describe a "detecting one of the communicating devices as the first communication device that did not communicate in the first period of time, and that was able to communicate in the second period of time."

Instead, during the first period of time, Kimura teaches the mobile module (first communicating device) remaining in an operational (Enabled) state and in communication with the second communication device (docking station). Such teachings contradict the claimed invention where the first communicating device is in a Disabled state in which the first communication device does not communicate for a first period of time, and in an Enabled state in which the first communication device does communicate for a second period of time. This difference in operation assists in identifying the first communicating device.

In light of the foregoing, Applicant respectfully requests the Examiner to withdraw the outstanding §102 rejection.

### ***Rejection Under 35 U.S.C. §103***

Claims 5, 10 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kimura in view of Jonsson (U.S. Patent Publication No. 2003/0036350). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

Appl. No. 10/809,561  
Amdt. Dated December 20, 2006  
Reply to an Office Action dated 09/20/06

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

With respect to dependent claims 5 and 10, neither Kimura nor Jonsson, alone or in combination, describes or suggests that the second period of time, which is construed to be the time of re-connection in Kimura, is until the "receiving means receives a response from an external device that the receiving means did not receive a response provided for the first period of time." The Office Action contends that Jonsson teaches receiving responses to an inquiry and presenting the answering devices on a display where one is selected for connectivity. *See Page 11 of the Office Action.* However, such teachings are not directed to the particulars concerning the claimed second period of time.

With respect to claim 17, Applicant respectfully submit that neither Kimura nor Jonsson, alone or in combination, describe or suggest the operation of detecting one of the communication devices as the first communication device that did not respond to the first inquiry and did respond to the second inquiry as claimed.

Reconsideration of the pending claims and subsequent withdrawal of the outstanding §103(a) rejection as applied to claims 5, 10 and 17 is respectfully requested.

Claims 11-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kimura in view of Sekiyama (U.S. Patent No. 6,427,115). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established. However, based on the dependency of claims 11-13 on independent claim 1, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments if an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 11-13 is respectfully requested.

Appl. No. 10/809,561  
Amdt. Dated December 20, 2006  
Reply to an Office Action dated 09/20/06

RECEIVED  
CENTRAL FAX CENTER  
DEC 20 2006

### Conclusion

Allowance of the claims at an early date is solicited. The examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: December 20, 2006

By

William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, California 90025

### CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

FACSIMILE

☐ deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, PO Box 1450,  
Alexandria, VA 22313-1450.

☒ transmitted by facsimile to the Patent and  
Trademark Office.

Date: 12/20/2006

  
Susan McFarlane

12/20/2006

Date